

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Alexander Franz et al. Art Unit : 2626
Patent No. : 7,555,428 Examiner : Paras D. Shah
Issue Date : June 30, 2009 Conf. No. : 1475
Serial No. : 10/647,203
Filed : August 21, 2003
Title : SYSTEM AND METHOD FOR IDENTIFYING COMPOUNDS THROUGH
ITERATIVE ANALYSIS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 574 to 915 days, is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of

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35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” “B delay” begins only after the PTO has failed to issue a patent within three years, not before. *Id.*

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before October 21, 2004 (the date that is fourteen months after August 21, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on January 19, 2007, thereby according a PTO Delay of 820 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from October 22, 2004 (the day after the date that is fourteen months after the date on which the application was filed), to January 19, 2007. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 820 days.

“B Delay”

The period beginning on August 22, 2006 (the day after the date that is three years after August 21, 2003, the date on which the application was filed), and ending June 30, 2009 (the date the patent was issued), is 1044 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on December 26, 2007, and the patent issued on June 30, 2009, resulting in a period of 552 days that must be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, “B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of

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Allowance. In the present application, no Notice of Appeal was filed.

See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of “B Delay” detailed above, the total “B Delay” for this patent should be calculated as 492 days (i.e., 1044 days minus 552 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO’s calculation of this “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 492 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of “A Delay” and “B Delay”

As detailed above, “A Delay” accumulated during the following period:

October 22, 2004, to January 19, 2007.

As detailed above, “B Delay” accumulated during the following period:

August 22, 2006, to December 26, 2007.

As such, the periods of “A Delay” and “B Delay” overlap (i.e., occur on the same calendar day) for a total of 151 days, from August 22, 2006, to January 19, 2007.

Applicant Delay

A reply to a Notice to File Missing Parts was due on or before February 18, 2004 (the date that is three months after November 18, 2003, the date on which the Notice to File Missing Parts was mailed). Patentee filed a response to the Notice to File Missing Parts on February 23, 2004, thereby according an Applicant Delay of 5 days. Patentee does not dispute the PTO’s calculation for this Applicant Delay from February 19, 2004 (the day after the date that is three months after the date on which the Notice to File Missing Parts was mailed), to February 23, 2004. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before April 19, 2007 (the date that is three months after January 19, 2007, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on June 19, 2007, thereby according an Applicant Delay of 61 days. Patentee does not dispute the PTO’s calculation for this Applicant Delay from

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April 20, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to June 19, 2007. See 37 C.F.R. § 1.704(b).

The Office mailed a Notice of Non-Compliant Amendment on June 25, 2007, that indicated that Patentees' response to Office Action filed on June 19, 2007, contained an error or omission. Patentees filed a complete response to that notice on July 10, 2007, resolving the error or omission. The PTO thereby accorded an Applicant Delay of 21 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from June 20, 2007 (the day after the date that the non-compliant amendment to the Office Action was filed), to July 10, 2007. See 37 C.F.R. § 1.704(c)(7).

A reply to an Office Action was due on or before November 24, 2007 (the date that is three months after August 24, 2007, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on December 26, 2007, thereby according an Applicant Delay of 32 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from November 25, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to December 26, 2007. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before May 22, 2008 (the date that is three months after February 22, 2008, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on August 21, 2008, thereby according an Applicant Delay of 91 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from May 23, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to August 21, 2008. See 37 C.F.R. § 1.704(b).

The Office mailed a Notice of Non-Compliant Amendment on September 22, 2008, that indicated that Patentees' response to Office Action filed on August 21, 2008, contained an error or omission. Patentees filed a complete response to that notice on September 26, 2008, resolving the error or omission. The PTO thereby accorded an Applicant Delay of 36 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from August 22, 2008 (the day after the date that the non-compliant amendment to the Office Action was filed), to September 26, 2008. See 37 C.F.R. § 1.704(c)(7).

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In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 246 days (i.e., the sum of 5 days, 61 days, 21 days, 32 days, 91 days, and 36 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 574 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1161 days (i.e., the sum of 820 days of "A Delay" and 492 days of "B Delay," minus 151 days of overlapping delay);
- 2) Total Applicant Delay should be calculated as 246 days (i.e., the sum of 5 days, 61 days, 21 days, 32 days, 91 days, and 36 days); and
- 3) Total PTA should be calculated as 915 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 16113-1230001.

Respectfully submitted,

Date:August 31, 2009

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